

ESTTA Tracking number: **ESTTA721191**

Filing date: **01/19/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Merck Sharp & Dohme Corp.
Granted to Date of previous extension	01/17/2016
Address	One Merck Drive Whitehouse Station, NJ 08889 UNITED STATES

Attorney information	Keith E. Sharkin Reed Smith LLP 599 Lexington Avenue New York, NY 10022 UNITED STATES clackert@reedsmith.com, ksharkin@reedsmith.com, smurawski@reedsmith.com, jgoodwill@reedsmith.com, nycipdocketing@reedsmith.com Phone:212-521-5400
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Applicant Information

Application No	86619397	Publication date	07/21/2015
Opposition Filing Date	01/19/2016	Opposition Period Ends	01/17/2016
Applicant	bioCSL Inc. 1020 First Avenue, P.O. Box 60446 King of Prussia, PA 19406 UNITED STATES		

Goods/Services Affected by Opposition

Class 001. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Chemical and biological reagents for scientific use and/or for non-medical purposes; cell cultures and media for scientific use and/or for non-medical purposes; test kits for scientific and/or non-medical use for anti-body screening, bloodgrouping or for detection of specific blood cells, antigens or immunoglobulin subtypes; chemical preparations for scientific and/or industrial purposes; diagnostic and testing agents for scientific use and/or for non-medical purposes; chemical and biological reagents for industrial use for anti-body screening, blood grouping, and for the typing and detection of specific blood cells, determining the presence of antigens on blood cells, and the detection of relevant complement compounds and immunoglobulin subtypes; chemical test kits for the detection of specific blood cells, determining the presence of antigens on blood cells, and the detection of relevant complement compounds and immunoglobulin subtypes for laboratory or research use; chemical preparations for industrial use for anti-body screening, blood grouping, and the typing and detection of specific blood cells

Class 005. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Vaccines; blood products, namely, immunoglobulins for medical or clinical use; serums for the treatment of influenza; antibodies; influenza vac-

cines; adjuvants and antigens; pharmaceutical preparations and substances for the treatment and/or prevention of blood or bleeding disorders, or diseases caused by bacteria and viruses; blood products, namely, blood plasma, and reagent blood cells; products derived from blood and products derived from recombinant DNA technology, namely, immunoglobulins, human albumin, blood clotting factors, plasma volume expanders, blood proteins for therapeutic use; serums, namely, anti-venoms; medicated serums for the treatment of blood or bleeding disorders; test kits, namely, invitro diagnostic reagent test kits for use in detecting cell mediated immune response; pharmaceutical preparations and substances, namely, RhD reagents for the detection of specific antigens or in blood typing; pharmaceutical preparations, namely, reagent red blood cells used to detect antibodies or IgG subtypes; pharmaceutical preparations, namely, monoclonal and polyclonal antibodies, and antibodies for use in the treatment of infectious diseases; pharmaceutical preparations, namely, reagents for medical/clinical use for the typing and detection of specific blood cells, and the detection of relevant complement components and immunoglobulin subtypes


Class 044. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Medical services; medical information services; health care services; health care information services; providing medical information concerning blood products; providing medical information concerning vaccines, anti-venoms and immunohaematology products, namely, diagnostic reagents; patient support services, namely, providing an Internet-based database of patient medical information where patients can inquire about medical issues and procedures from other patients and can relay information about their medical experiences for support and community

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86327887	Application Date	07/03/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SIGERTUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 0 First Use In Commerce: 0 Pharmaceutical preparations for treating diabetes		

Attachments	86327887#TMSN.png(bytes) NOO - SEQIRUS.pdf(272176 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Keith E. Sharkin/
Name	Keith E. Sharkin
Date	01/19/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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MERCK SHARP & DOHME CORP.,	:
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Opposer,	:
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v.	:
	:
bioCSL Inc.,	:
	:
Applicant.	:
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Opposition No.

NOTICE OF OPPOSITION

TO THE COMMISSIONER FOR TRADEMARKS:

MERCK SHARP & DOHME CORP., a New Jersey corporation located and doing business at One Merck Drive, Whitehouse Station, New Jersey 08889 (“Opposer”), believes that it will be damaged by the registration of application Serial No. 86/619,397 for the designation SEQIRUS for “chemical and biological reagents for scientific use and/or for non-medical purposes; cell cultures and media for scientific use and/or for non-medical purposes; test kits for scientific and/or non-medical use for anti-body screening, blood grouping or for detection of specific blood cells, antigens or immunoglobulin subtypes; chemical preparations for scientific and/or industrial purposes; diagnostic and testing agents for scientific use and/or for non-medical purposes; chemical and biological reagents for industrial use for anti-body screening, blood grouping, and for the typing and detection of specific blood cells, determining the presence of antigens on blood cells, and the detection of relevant complement compounds and immunoglobulin subtypes; chemical test kits for the detection of specific blood cells, determining the presence of antigens on blood cells, and the detection of relevant complement compounds and immunoglobulin subtypes for laboratory or research use; chemical preparations

for industrial use for anti-body screening, blood grouping, and the typing and detection of specific blood cells” in Class 1; “vaccines; blood products, namely, immunoglobulins for medical or clinical use; serums for the treatment of influenza; antibodies; influenza vaccines; adjuvants and antigens; pharmaceutical preparations and substances for the treatment and/or prevention of blood or bleeding disorders, or diseases caused by bacteria and viruses; blood products, namely, blood plasma, and reagent blood cells; products derived from blood and products derived from recombinant DNA technology, namely, immunoglobulins, human albumin, blood clotting factors, plasma volume expanders, blood proteins for therapeutic use; serums, namely, anti-venoms; medicated serums for the treatment of blood or bleeding disorders; test kits, namely, invitro diagnostic reagent test kits for use in detecting cell mediated immune response; pharmaceutical preparations and substances, namely, RhD reagents for the detection of specific antigens or in blood typing; pharmaceutical preparations, namely, reagent red blood cells used to detect antibodies or IgG subtypes; pharmaceutical preparations, namely, monoclonal and polyclonal antibodies, and antibodies for use in the treatment of infectious diseases; pharmaceutical preparations, namely, reagents for medical/clinical use for the typing and detection of specific blood cells, and the detection of relevant compliment components and immunoglobulin subtypes” in Class 5; and “medical services; medical information services; health care services; health care information services; providing medical information concerning blood products; providing medical information concerning vaccines, anti-venoms and immunohaematology products, namely, diagnostic reagents; patient support services, namely, providing an Internet-based database of patient medical information where patients can inquire about medical issues and procedures from other patients and can relay information about their medical experiences for support and community” in Class 44, filed on May 5, 2015 by bioCSL

Inc., a Delaware corporation, located at 1020 First Avenue, P.O. Box 60446, King of Prussia, Pennsylvania 19406 (“Applicant”), which application was published for opposition in the Official Gazette of July 21, 2015, and having previously been granted extensions of time to oppose hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is a leader in the worldwide health care market, and is engaged in the business of manufacturing, distributing and selling pharmaceutical products.

2. Opposer is the owner of application Serial No. 86/327,887 filed on July 3, 2014 for the mark SIGERTUS for “pharmaceutical preparations for treating diabetes” in Class 5 on the Principal Register of the United States Patent and Trademark Office. A notice of allowance for the mark issued on January 27, 2015.

3. Applicant, on or about May 5, 2015, filed intent-to-use application Serial No. 86/619,397 on the Principal Register of the United States Patent and Trademark Office for the mark SEQIRUS for “chemical and biological reagents for scientific use and/or for non-medical purposes; cell cultures and media for scientific use and/or for non-medical purposes; test kits for scientific and/or non-medical use for anti-body screening, blood grouping or for detection of specific blood cells, antigens or immunoglobulin subtypes; chemical preparations for scientific and/or industrial purposes; diagnostic and testing agents for scientific use and/or for non-medical purposes; chemical and biological reagents for industrial use for anti-body screening, blood grouping, and for the typing and detection of specific blood cells, determining the presence of antigens on blood cells, and the detection of relevant complement compounds and immunoglobulin subtypes; chemical test kits for the detection of specific blood cells, determining the presence of antigens on blood cells, and the detection of relevant complement

compounds and immunoglobulin subtypes for laboratory or research use; chemical preparations for industrial use for anti-body screening, blood grouping, and the typing and detection of specific blood cells” in Class 1, “vaccines; blood products, namely, immunoglobulins for medical or clinical use; serums for the treatment of influenza; antibodies; influenza vaccines; adjuvants and antigens; pharmaceutical preparations and substances for the treatment and/or prevention of blood or bleeding disorders, or diseases caused by bacteria and viruses; blood products, namely, blood plasma, and reagent blood cells; products derived from blood and products derived from recombinant DNA technology, namely, immunoglobulins, human albumin, blood clotting factors, plasma volume expanders, blood proteins for therapeutic use; serums, namely, anti-venoms; medicated serums for the treatment of blood or bleeding disorders; test kits, namely, invitro diagnostic reagent test kits for use in detecting cell mediated immune response; pharmaceutical preparations and substances, namely, RhD reagents for the detection of specific antigens or in blood typing; pharmaceutical preparations, namely, reagent red blood cells used to detect antibodies or IgG subtypes; pharmaceutical preparations, namely, monoclonal and polyclonal antibodies, and antibodies for use in the treatment of infectious diseases; pharmaceutical preparations, namely, reagents for medical/clinical use for the typing and detection of specific blood cells, and the detection of relevant compliment components and immunoglobulin subtypes” in Class 5; and “medical services; medical information services; health care services; health care information services; providing medical information concerning blood products; providing medical information concerning vaccines, anti-venoms and immunohaematology products, namely, diagnostic reagents; patient support services, namely, providing an Internet-based database of patient medical information where patients can inquire about medical issues and procedures from other patients and can relay information about their

medical experiences for support and community” in Class 44.

4. The filing date for Opposer’s SIGERTUS application was before the filing date of the intent-to-use application herein opposed, and as such Opposer has priority over Applicant.

5. Upon information and belief, Applicant has not used the SEQIRUS mark in commerce.

6. Applicant’s pharmaceutical preparations, chemical and biological products, and medical and health care services which are to be offered under the alleged mark SEQIRUS are closely related to the pharmaceutical preparations to be offered by Opposer under the SIGERTUS mark.

7. The goods and services covered by the application for the alleged mark SEQIRUS will be encountered by the same or similar class of purchasers as those who are interested in or familiar with the goods to be offered by Opposer under the SIGERTUS mark.

8. Applicant’s designation SEQIRUS is so similar to Opposer’s SIGERTUS mark as to be likely, when applied to Applicant’s goods and services, to cause confusion, to cause mistake, and to deceive with consequent injury to Opposer and the public.

9. Applicant’s designation SEQIRUS so closely resembles Opposer’s SIGERTUS mark that potential purchasers of the goods and services to be offered under Applicant’s alleged mark would be likely to believe that Opposer is the source of such goods and services, or that Opposer has authorized, sponsored, approved of, or in some others manner associated itself with the goods and services of Applicant, thereby creating a likelihood of confusion, deception or mistake, all to the damage of Opposer.

10. Opposer will be damaged by the registration sought by Applicant because such registration would support and assist Applicant in the confusing and misleading use of

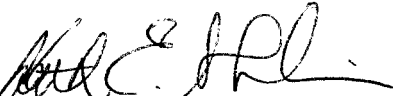
Applicant's mark and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer to the SIGERTUS mark.

11. By reason of the foregoing, Opposer believes that it will be damaged by the registration of Applicant's claimed trademark.

WHEREFORE, Opposer requests that the opposition to application Serial No. 86/619,397 for registration of SEQIRUS be granted and that the registration sought by Applicant be denied.

Dated: January 19, 2016

REED SMITH LLP

By: 
Keith E. Sharkin

599 Lexington Avenue
New York, NY 10022
Telephone: (212) 521-5400
Facsimile: (212) 521-5450

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing Notice of Opposition was deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Applicant's attorney of record:

Donald S. Gardner, Esq.
Gardner Linn Burkhardt & Flory LLP
2851 Charlevoix Drive, Suite 207
Grand Rapids, Michigan 49546-7090

On January 19, 2016

A handwritten signature in black ink, appearing to read 'Jonathan Goodwill', is written over a horizontal line.

Jonathan Goodwill